

**REMARKS**

Claims 1-19 are pending in this application. By this Amendment, claims XXX are amended. No new matter is added. Claims 1, 16, and 17 are the independent claims.

Favorable reconsideration of this application, in light of the preceding amendments and following remarks, is respectfully requested.

**Petition to Suspend Office Action**

Applicant note that the instant response is filed concurrently with a Petition for Suspension of Action under 37 C.F.R. § 1.103(a), which is filed to provide Applicant more time to may determine the commercialibility of example embodiments of the present invention. Further, Applicant notes that the arguments presented herein are believed to be fully responsive to the outstanding Office action, even without the additional evidence.

**Claim Objections**

Claims 1, 12, 14, and 17 are objected due to informalities. Specifically, the limitations of “second check means...”; second prioritizing means”; “second means for selecting”; “counting means for counting a number of recoccurrences of identical messages being received”; “means for measuring a frequency of messages to and from a specific sender”; “a second check device”; “a second prioritizing device” and “a second device for selecting” are not adequately described in the specification in such a manner that they can be easily identified.

Applicant submits that the features of the “second” checking means, prioritizing means, and selecting means, are described in *at least* originally filed disclosure at *page 4, line 28 - page 5, line 21; and referencing FIG. 1.*

More specifically, *page 4, line 28 - page 5, line 21* states that:

if the incoming email does not contain a valid key pair, the receiving server then checks if the insignia is on the allow list 13. **If the insignia is not on the allow list, the receiving server will send back a reply request to the sender by doing the steps described in the following text.** The receiving server generates an error message on the SMTP protocol that informs the sending server that the email could not be received because the sender is not registered as a valid sender of mail to the receiver 14. After this step, the SMTP communication is either closed by the sending server or a new email is delivered to the receiving server. The receiving server then prioritizes the incoming email according to a given rule set and assigns a priority value to the email message 15. If the assigned value is not exceeding a given threshold value, a Unique ID is generated by the receiving system 18. The incoming email, insignia and Unique ID is then stored by the receiving server for later retrieval 19. **The receiving server sends an email to the sender of the incoming email asking to reply to it without changing the subject line of the mime message (RFC 822) 20.** If the incoming email did get a priority value exceeding the given threshold value 16 the insignia of the sender is added to the allow list 17. If the incoming email sender insignia was on the allow list 13 then the receiving server captures the CC: from the mime message and stores them the predict allow list for later retrieval 11. The email is then delivered to the recipient mail box or forwarded to the next step 12. *(emphasis added)*

Accordingly, based on the above passage, it is respectfully submitted that the “second prioritizing means” may correspond to the means/device in step 15; the “second checking means” may correspond to the means/device in step 16; and the “second selecting means” may correspond to the means/device in step 18.

In view of the above, Applicant respectfully submits that all of the features are adequately described by the originally filed disclosure, and respectfully request reconsideration and withdrawal of the objection to the claims.

**Claim Rejections - 35 U.S.C. § 112**

Claims 1-15, 17, and 19 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant respectfully traverses this rejection for the reasons discussed below.

In regard to claims 12 and 14, Applicant has taken into consideration the Examiner's comments, and has amended claims 12 and 14 by removing the terms "means for" as suggested by the Examiner.

In regard to claims 1 and 17, Applicant submits that FIG. 1 clearly describes the feature of the "first prioritizing means/device and the second prioritizing means/device are associated with the first message and the second message, respectively." For instance, as described in *page 4, line 28 - page 5, line 32 of the originally filed disclosure*, if the email did contain a valid key pair 4, the receiving server will prioritize the email message and assign it a priority value 5 to be added to the allowed list 9. If, however, the incoming email does not contain a valid key pair, the receiving server then checks if the insignia is on the allow list 13. If the insignia is not on the allow list, the receiving server will send back a reply request to the sender to prioritize the incoming email according to a given rule set and assign a priority value to the email message. If the incoming email did get a priority value exceeding the given threshold value, the insignia of the sender is added to the allow list and send back to the receiving server. The latter step clearly describes the feature of the "second message is received being a reply to the returned message."

In view of the above, Applicant respectfully request reconsideration and withdrawal of the 35 U.S.C. § 112, second paragraph.

**Claim Rejections - 35 U.S.C. § 103**

Claims 1-4, 6-9, 11, and 14-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,691,156 (“Drummond”) in view of U.S. Patent No. 2002/0120705 (“Schiavone”). Applicant respectfully traverses this rejection for the reasons discussed below.

Applicant respectfully submits that Drummond and Schiavone, individually or in combination, fail to disclose or suggest, will describe or suggest, *inter alia*:

first prioritizing means which assigns a priority to each of the first identification insignias of the senders of the first message, ....

second prioritizing means which, in response to recognition of the second message being a reply to the returned message, assigns a priority to each of the identification insignias of the senders of the returned messages, ....

Specifically, Schiavone fails to disclose or suggest the features of “first prioritizing means which assigns a priority to each of the first identification insignias of the senders of the first message” and “second prioritizing means which, in response to recognition of the second message being a reply to the returned message.”

Contrarily, Applicant submits that Schiavone is only concerned with **assigning priorities to network paths based on content of a message**. See paragraphs [0023] and [0034] of Schiavone. Schiavone is **not** concerned with assigning of priorities to identification insignias of the senders, and hence does **not** disclose, *among other things*, “second prioritizing means which, in response to recognition of the second message being a reply to the returned message, assigns a priority to each of the

identification insignias of the senders of the returned messages,” as recited in claim 1.

Further, it is submitted that Schiavone evaluates the content or other characteristics of the message itself to determine a priority which is then assigned to a network path used for delivering the message, whereas the features of claim 1 is directed to **“assigning a priority to the insignia of the sender.”**

In addition, in the outstanding Office Action, *c.f.*, pages 3 and 4 in the Office Action, the Examiner alleges that:

Schiavone discloses (par. 0034) where incoming message is received by the network appliance and priority information is assigned to message and (par. 0019) where mailers may be prioritized using source address. Schiavone also discloses (par. 0020) all e-mail from a given sender (i.e., email address) or domain (i.e., IP address) may be assigned a priority and (0017) where viewable portion of the message, e.g., body, subject line, etc. of the message may be used as the priority information.....

However, it is submitted that Schiavone is completely silent of teaching or suggesting **“second prioritizing means which, in response to recognition of the second message being a reply to the returned message, assigns a priority to each of the identification insignias of the senders of the returned messages.”** Schiavone merely discusses allowing compliant email hosts to ensure that message priority is taken into account in message processing and handling – rather than to the “second message” being a reply to the returned message.

Furthermore, claim 1 discloses that the means for selecting and adding identification insignias to the allowed list is adapted to carry out the selection according to the priorities assigned to the identification insignias. In contrast, Schiavone discloses assigning priorities to the emails themselves – not to the identification insignias as taught in claim 1. Also, the means for selecting identification insignia of claim 1 is the means for adding the selected insignias to the

allowed list. As such, the means may be adapted to carry out the selection according to the priorities. Therefore, Schiavone discloses prioritizing the email itself and does not disclose that the prioritizing can be used when carrying out the adding of the insignias to the allowed list.

Finally, the term “*insignia*” (described in page 6, third paragraph of the instant disclosure), of claim 1 may be related to a priority being assigned to an e-mail address or domain name or similar identification insignia which identifies the sender, rather than a “network path” or other information which is related to the message (rather than to the sender), as taught by Schiavone. Therefore, one skilled in the art would appreciate that Schiavone, which teaches prioritizing a “network path,” cannot at all be assigned a priority to an insignia of the sender since it is known that the network path for a specific sender will change constantly. Therefore, the proposed combination of reference of Drummond and Schiavone, would not arrive at the system according to claim 1, where a priority is assigned to each of the identification insignias of the senders of the messages; but rather to a system where the content of the message or the network path by which it was delivered leads to prioritizing the messages. Moreover, Applicant respectfully submits that one of ordinary skill in the art would not have a *reasonable expectation of success* since the prioritization method of the “network path” as taught in Schiavone would render the proposed combination *unworkable*. Therefore, the rejection failed to articulate a proper rationale to support an obviousness rejection.

Accordingly, Applicant respectfully submits that no *prima facie* case of obviousness has been established with respect to amended claim 1.

In view of the above, Applicant respectfully submits that Drummond and Schiavone, individually or in combination, fail to teach or suggest each and every element of claim 1, and, therefore, claim 1 is allowable over this cited art. Claims 2-4, 6-9, 11, 14, and 15, are dependent from claim 1, and therefore, also allowable.

Claim 16 (and claim 17) is directed to a method claim which corresponds to claim 1. Applicant respectfully submits that this claim is also allowable for the similar reasons presented above in regard to amended claim 1.

Accordingly, Applicant respectfully requests that the rejection under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

Claims 5, 10, and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Drummond and Schiavone in view of U.S. Patent Application Publication No. 2004/0205127 ("Ben-Yosef"). Applicant respectfully traverses this rejection for the reasons discussed below.

Claims 5, 10, and 13 are believed to be allowable for at least the reasons set forth above regarding claim 1. Ben-Yosef fails to provide the teachings noted above as missing from Drummond and Schiavone. Since claims 5, 10, and 13 are patentably at least by virtue of their dependency on claim 1, Applicant respectfully requests that the rejection of claims 5, 10, and 13 under 35 U.S.C. § 103(a) be withdrawn.

Claim 12 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Drummond and Schiavone and Ben-Yoseph in view of U.S. Patent No. 6,330,590 ("Cotten"). Applicant respectfully traverses this rejection for the reasons discussed below.

Claim 12 is believed to be allowable for at least the reasons set forth above regarding claim 1. Cotten fails to provide the teachings noted above as missing from Drummond and Schiavone. Since Claim 12 is patentably at least by virtue of its dependency on claim 1, Applicant respectfully requests that the rejection of claim 12 under 35 U.S.C. § 103(a) be withdrawn.

### **CONCLUSION**

In view of the above remarks and amendments, Applicant respectfully submits that each of the pending objections and rejections has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested. Further, the above remarks demonstrate the failings of the outstanding rejections, and are sufficient to overcome the rejections. However, these remarks are not intended to, nor need they, comprehensively address each and every reason for the patentability of the claimed subject matter over the applied prior art. Accordingly, Applicant does not contend that the claims are patentable solely on the basis of the particular claim elements discussed above.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant hereby petitions for a three (3) month extension of time for filing a reply to the outstanding Office Action and submit the required extension fees herewith.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned, at the telephone number below.



If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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By

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Attachment: Petition to Suspend Office Action under 37 CFR 1.103(a)

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